

REMARKS/ARGUMENTS

Applicants have received and carefully reviewed the Office Action of May 8, 2008. In this Office Action, claims 9-12, 16, 17, and 19-23, have been rejected. In this amendment, claim 9 has been changed, claims 10-11 have been canceled, and no new material has been added. Reconsideration is requested in light of the amendment and the following comments.

Independent claim 9 was rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Muni et al. (U.S. Patent No. 5,316,706). Applicants respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP 2143.03). Examiner noted that the device of Muni et al. only needed to be capable of slidable use with a guide wire with a first diameter and a distal stop having a second diameter greater than the first diameter. Applicants have amended claim 9 to positively recite a guidewire with a first diameter and a distal stop having a second diameter greater than the first diameter. There does not appear to be any reference to this claimed structure by Muni et al.

Examiner admits that Muni et al. do not disclose that the radially inextensible portion is distal to the elastic portion. Examiner cites the specification language of Muni et al. in column 4, lines 18-22, “the present invention is not limited to a catheter having a relatively stiff body portion and a flexible distal end. The crystallinity of a device may be varied in any of a plurality of zones throughout its length,” as supporting a 35 U.S.C. § 103(a) obviousness rejection. The Applicants respectfully disagree. “The fact-findings should specifically articulate what teachings or suggestions in the prior art would have motivated one of ordinary skill in the art to select the claimed species or subgenus.”

Kulling, 897 F.2d at 1149, 14 USPQ2d at 1058; *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1579 n.42, 1 USQP2d 1593, 1606 n.42 (Fed. Cir. 1987). (MPEP 2144.08). “Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). (MPEP 2143.01).

Without conceding the correctness of the Examiner's assertion, the spirit of the specification language may appear to support varying the crystalline zones in the stiffened portion of the device (column 3, lines 35-39), perhaps to allow some degree of reduced stiffness (or increased flexibility) in this portion. However, the distal tip appears to remain entirely flexible in every embodiment. It appears to be clearly stated in the Muni et al. specification, including the description of the method of manufacture, that the entire distal tip is flexible, and there does not appear to be specific support for crystallizing any portion of the flexible tip beyond the Examiner's conclusory remarks supported only by the relatively generic specification language cited above.

The Examiner also pointed out that the claim language did not require that the distal-most portion of the catheter is the radially inextensible ring, only that a portion of the tip distal to the elastic portion is radially inextensible. Applicants respectfully point out that this was claimed as part of dependent claims 10 and 11, which have currently been canceled and incorporated into independent claim 9. Muni et al. do not appear to disclose this feature.

Additionally, the proposed modification of Muni et al. that the Examiner cites as obvious to one of ordinary skill in the art may actually render the Muni et al. device unsuitable for its intended use. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). "Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). (MPEP 2143.01). Therefore, Applicants believe that the rejection of claim 9 in view of Muni et al. is flawed and withdrawal of the rejection is respectfully requested.

The Examiner also rejected independent claim 9, along with claims 10-12, 16, 17, and 19-23 which depend therefrom, using the previous rejection combination of Van Tassel et al. (U.S. Patent No. 4,531,943) in view of Muni et al. Applicants respectfully traverse this rejection.

“*** “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).” (MPEP 2143.03).

The Examiner asserted that Van Tassel et al. disclose a medical device capable of being used with a guidewire (and pointed out that Applicants had not positively claimed a guidewire) but admits that Van Tassel et al. do not disclose that the lumen is a guidewire receiving lumen. Currently amended claim 9 positively recites a guidewire having a first diameter and a distal stop having a second diameter greater than the first diameter. Muni et al. do not appear to remedy this deficiency.

The Examiner further admits that Van Tassel et al. do not disclose that the tip comprises an amorphous polymer or that the radially inextensible distal portion comprises a locally crystalline section thereof. The Examiner asserts that Muni et al. provide the missing elements of Van Tassel et al. The Applicants respectfully disagree and also assert that Van Tassel et al. do not appear to disclose that the distal portion of the tip is radially inextensible. Instead, Van Tassel et al. appear to disclose that the tip has an increase in material defining a ring which stabilizes and strengthens the opening preventing it from sagging. While some plastics may offer some natural resistance to deformation under their own weight, it appears that such a tip, with no stiffened or rigid structure at the tip opening, would be able to stretch upon encountering an obstacle, such as a guidewire stop. Additionally, Van Tassel et al. discloses (column 5, lines 26-29) “the soft plastic tip will deform by spreading” upon coming into contact with an obstacle. Therefore, it is unclear to the Applicants what makes the tip disclosed by Van Tassel et al. radially inextensible.

The combination does not appear to show each claimed element, particularly in view of the current claims, and Applicants also believe that the rejection based on the combination of Van Tassel et al. and Muni et al. is flawed because there does not appear to be any reason for one skilled in the art to use the Muni et al. device in the way that the Examiner proposes (as discussed above). Therefore, the asserted combination of Van

Tassel et al. in view of Muni et al. creates a flawed *prima facie* obviousness rejection, and Applicants request that the rejection be withdrawn.

Claims 10-11 were canceled with this amendment, rendering their rejection moot.

For at least the reasons discussed above, as well as others, claims 12, 16-17, and 19-23, which depend from claim 9 and add additional elements thereto, are also believed to be patentable over the asserted combination. Applicants request that the Examiner withdraw the rejections.

Reexamination and reconsideration are respectfully requested. It is submitted that all pending claims are currently in condition for allowance. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at 612.677.9050.

Respectfully submitted,

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By their Attorney,

Date:

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